

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed:
September 12, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Karsten Manufacturing Corporation

Serial No. 78347910

John D. Titus of The Cavanagh Law Firm for Karsten
Manufacturing Corporation.

Sean W. Dwyer, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Seeherman, Hohein and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Karsten Manufacturing Corporation has appealed from
the final refusal of the Trademark Examining Attorney to
register the design shown below for "golf clubs."¹

¹ Application Serial No. 78347910, filed January 5, 2004, and
asserting first use and first use in commerce on August 27, 2003.



Citing Trademark Rule 2.51(a)(1), the Examining Attorney has refused registration on the basis that the mark depicted on the drawing does not agree with the mark as it appears on the specimens. Specifically, the Examining Attorney asserts that "the drawing displays the mark as a wedge design with one side dark the other side clear, and the specimen depicts the mark as the same wedge design with the mark PING USA in the dark side and a G2 design on the clear side." Final Office action, mailed August 31, 2004. In order to better understand the Examining Attorney's position, we reproduce below the specimen submitted by applicant:



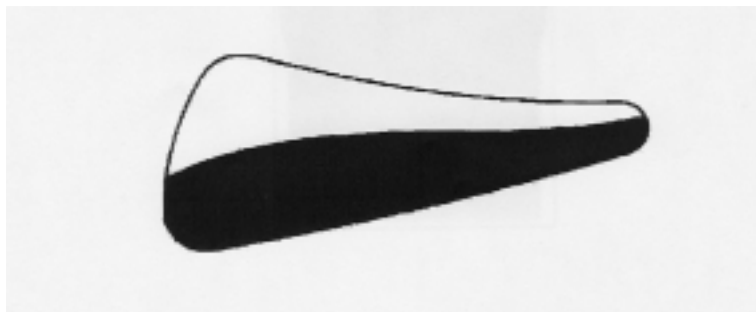
The appeal has been fully briefed. Applicant did not request an oral hearing.

Trademark Rule 2.51(a)(1) provides that, "in an application under section 1(a) of the Act" (as is the case herein), "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services." The Examining Attorney asserts that the mark shown in applicant's drawing is not a substantially exact representation because it does not include "PING," "G2" and "USA," which are on the wedge design as it appears on the specimen. It is the Examining Attorney's position that the combination of these literal elements on the wedge design creates a unitary mark, and therefore the wedge design cannot be separated from the wording without mutilating the mark as a whole.

Applicant, on the other hand, argues that its wedge design is a distinctive background, and therefore it is separately registrable. In support of its position that the background design creates a visual impact that is separate from the words superimposed on the design, applicant has submitted 23 declarations from golf customers and dealers, all of whom state that applicant's wedge design is distinctive separate and apart from the writing on the design:

The shape and dark/light pattern of the G2 medallion logo is immediately recognizable at a distance much greater than the distance at which any writing inside the logo is recognizable. For example, I believe the G2 logo is immediately recognizable on a set of golf clubs sitting in a golf bag to persons on a golf course or at the clubhouse, irrespective of whether the writing inside the logo is legible. For that reason, I believe the wedge shaped contour of PING G2 logo is distinctive separate and apart from the words that accompany the logo.

We note that the wedge design which has been inserted on each of the declarations shows the "logo" to which the declarants refer in a different form from that shown in the drawing in the application, namely, rotated 180 degrees so that the light portion of the wedge appears on the top and the dark portion of the wedge on the bottom, as follows:



This is the same manner in which the design appears on the specimens, such that the wording on the design is "right-side up."

In In re National Institute for Automotive Service Excellence, 218 USPQ 744, 745 (TTAB 1983), the Board

discussed the question of the registrability of background designs, stating:

{I}t is settled that when a background design used for the display of a word or letter mark is sought to be registered by itself, without the word or letter mark, the design may be registered without any evidence of secondary meaning if it is distinctive or unique enough to create a commercial impression as an indication of origin separate and apart from the remainder of the mark; conversely, if it is not distinctive or unique enough to create a separate commercial impression as a trademark, it may be registered only upon proof of secondary meaning.

The Board went on to explain the rationale for this view, quoting *Permatex Company, Inc. v. California Tube Products, Inc.*, 175 USPQ 764, 766 (TTAB 1972):

It is settled that common basic shapes such as circles, ovals, triangles, diamonds, stars, and other geometric designs, when used as vehicles for the display of word or letter marks, are not regarded as indicia of origin for the goods to which they are applied in the absence of a showing of secondary meaning in the design alone. The rationale behind these cases is that designs of this character have been so commonly employed as background devices for word marks that composite marks of this type create but a single commercial impression with the result that purchasers would normally utilize the word portions of the marks to identify and distinguish the goods sold thereunder; and that differences between word portions of different marks utilizing the same common

background design would generally be sufficient to avoid trade confusion. There are [sic], however, a line of cases that hold for the proposition that where the background design of a composite mark is not commonplace, but is unique or unusual in a particular field of endeavor, said design can be considered to be inherently distinctive and no proof of secondary meaning need be introduced to show that it functions as a trademark, separate and apart from the word feature, to identify a party's goods in commerce. In other words, where the background design of [a] unitary mark is inherently distinctive, the mark is deemed to consist of two separate features, either one of which can serve to identify the goods of the owner of the mark.

After considering the specimen, the various declarations, and the pertinent case law, we conclude that the background design that is the subject of this application creates a separate and distinct impression from the literal elements that appear on this design, and that the specimen supports registration of the design alone. Both the overall shape and the two internal figures, which appear in different colors, are somewhat unusual, and the resulting combination of shapes is also unusual. Certainly the design cannot be regarded as a common geometric shape, and the Examining Attorney does not contend that this is the case. Compare *In re Kerr-McGee Corporation*, 190 USPQ 204 (TTAB 1976).

The Examining Attorney appears to take the position that the background design and the literal elements form a unitary mark because the background design serves to accommodate the literal portion. However, although the literal elements are certainly present on the design as shown in the specimen, we do not find that the design is so interconnected with the literal elements that it may not be registered. That is, the overall shape of the design, and the internal shapes that comprise the overall shape, do not so closely mimic the shape of the literal elements that they would be viewed as connected. See *In re Cohn*, 122 USPQ 407 (TTAB 1959) (design showing lifeguard and lifesaver found registrable, even though specimens showed OIL GARD within the lifesaver and on the shirt of the lifeguard).

More importantly, applicant's mark is used on the head of a golf club and, as the declarations show, the shape and two-tone pattern would be discernible from a distance, even though the writing on the design would not be. Due to this manner of use, consumers would identify applicant's golf clubs by the design alone. This also supports the conclusion that the design creates a separate commercial impression. See *In re National Institute for Automotive Service Excellence*, supra at 745, in which the Board

specifically pointed out that "at a distance the words may be hard to read but the design stands out and provides a means of ready recognition," in finding that the design therein created a visual impact separate and apart from the words superimposed thereon and was therefore registrable without the words.

We find that the present situation is distinguishable from that in *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988), on which the Examining Attorney relies. In that case, the applicant sought to register as a separate mark the medicine dropper and droplet portion of the following mark:



The Court held that the three elements of the background—the dropper, the droplet and the watering can—were interrelated elements of a single unified design. However, in the present case applicant is seeking to register the entire background design, not merely a portion of it. Further, it is interesting to note that the Court accepted that the entire background design was separable from the

words 7 DROPS; the only question was whether a portion of that overall design could be separately registered. Thus, the mere fact that words appear on the background design does not necessarily prevent a background design from creating a separate commercial impression.

Decision: The refusal of registration is reversed. As previously noted, the mark as it appears in the drawing is rotated 180 degrees from the mark as shown in the specimen, such that the dark portion appears as the top part of the mark. Because the declarations include the mark with the dark portion on the bottom, it is suggested that applicant submit, within thirty days, an amended drawing showing the mark in the position in which it appears on the specimen.